

REMARKS

I. Status of the claims

Claims 1 and 3-9, 12, 13, and 15-26 are pending. Claims 10, 11, and 14 have been cancelled.

The subject matter of claims 10 and 11 has been incorporated into claim 1. Additionally, claims 1 and 13 have been amended to recite a preferred coating layer that comprises a hydroxy-terminated polyester. Support for this amendment may be found in the specification on page 3, lines 15-23. No new matter has been added through these amendments.

II. Rejection of claims 1 and 3-26 based on Saito

Claims 1 and 3-26 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over European patent Publication 917964 to Saito et al. ("Saito"). According to the examiner, Saito discloses polycarbonate resins that are encompassed by Applicants' claim element relating to polyester resins. Applicants respectfully traverse this rejection.

Applicants have amended claim 1 to recite a preferred coating layer that comprises a hydroxy-terminated polyester. Saito, on the other hand, relates only to polycarbonates. There is no disclosure in Saito relating to the functionality of the end groups of the polycarbonates. Specifically, there is no teaching or suggestion that the end groups of the polycarbonates may be hydroxy groups or that hydroxy-terminated polycarbonates provide the benefits of Applicants' claimed invention. Saito does not provide the requisite motivation for a skilled artisan to modify the disclosed polycarbonates with hydroxy-terminating groups. Furthermore, in view of the *aromatic* nature of polycarbonates disclosed in Saito, one skilled in the art would have no expectation that modifying the disclosed polycarbonates would be successful if introduced into the Saito coating. A skilled artisan would have no expectation that such a modification would successfully produce beneficial properties for a *non-aromatic* polyester, such as those used in Applicants' claimed invention.

Therefore, Saito fails to teach or suggest Applicants claimed invention, and Applicants respectfully request that the examiner withdraw this rejection.

III. Rejection of claims 1, 3-6, 8-10, 14, 15, 17, and 18 based on Hashimoto

The examiner rejected claims 1, 3-6, 8-10, 14, 15, 17 and 18 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,783,375 to Hashimoto et al. ("Hashimoto"). The rejection set forth in the previous Office Action has been maintained by the examiner.

Applicants note that the examiner did not reject claims 10, 11, 13, 21, 23, and 26. In this response, Applicants have amended claim 1 to incorporate the limitations of claims 10 and 11 into claim 1. As amended, all five pending independent claims—claims 1, 13, 21, 23, and 26—each contain limitations that the examiner has indicated are not anticipated or obvious over Hashimoto.

Accordingly, Applicants respectfully request the examiner to withdraw the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) based on Hashimoto.

IV. Rejection of claims 1, 3-10, 12, 14, 15, 17, and 18 based on Shimomine

The examiner rejected claims 1, 3-10, 12, 14, 15, 17, and 18 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,434,598 to Shimomine et al. ("Shimomine"). The rejection set forth in the previous Office Action has been maintained by the examiner.

Applicants note that the examiner did not reject pending claims 11, 13, 21, 23, and 26. In this response, Applicants have amended claim 1 to incorporate the limitations of claims 10 and 11 into claim 1. As amended, all five pending independent claims—claims 1, 13, 21, 23, and 26—each contain limitations that the examiner has indicated are not anticipated or obvious over Shimomine.

Accordingly, Applicants respectfully request the examiner to withdraw the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) based on Shimomine.

V. Conclusion

Applicants request reconsideration of this application in view of the amendments and remarks set forth above. The examiner is encouraged to contact the undersigned counsel in order to resolve any remaining issues.

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Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
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